

Remarks/Arguments**I. Status**

The Office Action dated March 2, 2010 (the “Office Action”), has been carefully reviewed. Claims 1, 6, 8, 20, and 25 have been amended. Accordingly, claims 1-11 and 20-30 are pending in this application. Reconsideration of this application is respectfully requested.

II. 35 U.S.C. § 112 Rejection

Claims 6 and 8 were rejected under 35 U.S.C. § 112. Claim 6 has been amended to depend from claim 4 and to provide proper antecedent basis. Claim 28 has been amended as suggested by the Examiner. Accordingly, the Applicants respectfully submit that the rejections under 35 U.S.C. § 112 have been overcome.

III. 35 U.S.C. § 102 Rejection

Claims 20, 22, and 25-28 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent Publication No. 2005/0149043 to Parry et al. (hereinafter “Parry”). Reconsideration of these claims in view of the following remarks is respectfully requested.

*Discussion Re: Patentability of Claim 20***1. Claim 20**

Claim 20 recites:

A kit providing a handheld instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe, the second end configured to sealingly engage with a head; and

a plurality of heads, each head having a curvilinear outer perimeter and configured to be operably attached to the second end portion of the shaft such that an inner channel of the head connects to the internal channel of the shaft, each of the plurality of heads having a curvilinear outer perimeter sized to at least partially fit within an acetabular liner and not substantially extend over a rim of the acetabular liner.

Claim 20, as amended, thus recites a device with a head that is configured to sealingly engage the inner surface of an *acetabular liner* and not substantially extend over a rim of the acetabular liner.

2. Parry is Only Partially Prior Art

As an initial matter, Parry was filed on April 30, 2004, which is after the filing date of the present application. Moreover, while an exhaustive review has not been made, Parry appears to include disclosures that were not made in the provisional applications to which priority is claimed by Parry. Therefore, the Applicants do not admit that any disclosure of Parry qualifies as prior art under 35 U.S.C. 102(e) for purpose of the arguments herein unless the same disclosure is found in the provisional applications to which priority is claimed by Parry.

3. Parry Does Not Disclose a Sealing Acetabular Liner Head

The Examiner alleged that Parry discloses a head configured to sealingly engage and acetabular liner. (Office Action at pages 3 and 4). Parry has been mischaracterized.

Specifically, the Examiner has alleged that the component identified with the reference number 100 is a head configured to sealingly engage and acetabular liner.

(Office Action at page 4). Reference number 100 is used by Parry to identify an

“engaging head”. (Parry at paragraph 60). The “engaging head” for which reference number 100 identifies an alternative embodiment, is the “shell-engaging head 18.” (See, e.g., Parry at paragraph 59). The shell engaging head 100 is thus configured to sealingly engage an *acetabular shell*, not an acetabular liner. Parry does, however disclose a liner engaging head 150. (Parry at paragraph 68 and FIGs. 8A, 8B, and 8C). As specifically stated by Provisional Application No. 60/541,344 at page 19, lines 12-15, the liner engaging head includes “relief grooves” to “prevent the formation of a vacuum between the socket liner inserter 150 and the socket liner.” Thus, the portion of Parry which may be considered prior art, specifically discloses a liner engaging head that is specially formed to *avoid* forming a vacuum. A head which is configured to *prevent* sealing engagement is not the same as a head configured to *provide* sealing engagement.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Parry does not disclose a head configured to sealingly engage an acetabular liner as required by Applicants’ claim 20, Parry does not anticipate claim 20. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 20.

4. Parry Does Not Disclose a Bulb Syringe Connection

Moreover, Claim 20 requires one end of the shaft to be “configured to sealingly engage with a bulb syringe.” The Examiner has alleged that Parry discloses this configuration. (Office Action at page 4). The Examiner has mischaracterized Parry.

Specifically, the Examiner has not identified any passage or figure in Parry which discloses this configuration. Nonetheless, Parry does not disclose such a configuration.

In fact, at page 17, lines 1-3, the Provisional Application No. 60/541,344 discloses that “there is no need for an external vacuum source to create a negative pressure inside of the hollow passage 54.”

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Parry does not disclose a head configured to sealingly engage with a bulb syringe as required by Applicants’ claim 20, Parry does not anticipate claim 20. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 20.

5. The Shell Engaging Head Extends Over the Shell Rim

Finally, claim 20 has been amended to recite that the claimed head is configured to “not substantially extend over a rim of the acetabular liner.” The shell-engaging head 100 of Parry, however, includes a base 102 which is configured to extend over the rim of the device with which it is used about the entire perimeter of the device. (See, e.g., FIG. 5 of Parry). A head which extends over the entire perimeter of the rim of the device which it holds is not the same as a head which does not substantially extend over a rim of the acetabular liner.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since the alleged head of Parry does not disclose a head which does not substantially extend over a rim of the acetabular liner as required by Applicants’ claim 20, Parry does not anticipate claim 20. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 20.

6. Conclusion

For any or all of the foregoing reasons, the Applicants respectfully submit that the rejection of claim 20 as being anticipated by Parry has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 20 under 35 U.S.C. § 102 should be withdrawn.

Discussion Re: Patentability of Claim 22

Claim 22 depends from claim 20 and includes all of the limitations of claim 20 along with additional limitations. Therefore, for at least the reasons set forth above with respect to claim 20, claim 22 is patentable over the prior art.

Discussion Re: Patentability of Claim 25

Claim 25 recites:

An instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a hand held vacuum producing device; and

a head having a curvilinear outer perimeter configured to abut a 360 degree portion of the inner surface of an acetabular liner and not substantially extend over a rim of the acetabular liner and operably attached to the second end portion of the shaft and having an inner channel therethrough operably connected to the internal channel of the shaft.

Claim 25, as amended, thus recites a head that is configured to engage the inner surface of an *acetabular liner* and not substantially extend over a rim of the acetabular liner. Claim 25, while not requiring a sealing engagement, does require abutment completely about the inner surface of an acetabular liner. Moreover, while not limited to a bulb syringe, claim 25 nonetheless requires a “hand held vacuum producing device.”

For purpose of this discussion, claim 25 thus includes limitations that are distinguishable over the disclosure of Parry for the same reasons set forth above with respect to claim 20.

Therefore, for the same reasons set forth above with respect to claim 20, claim 25 is patentable over the cited art.

Discussion Re: Patentability of Claims 26-28

Each of claims 26-28 depend, either directly or by way of another claim, from claim 25 and include all of the limitations of claim 25. Therefore, for at least the reasons set forth above with respect to claim 25, claims 26-28 are patentable over the prior art.

IV. 35 U.S.C. § 103 Rejections

Claims 1-11, 20-22, and 25-30 were rejected under 35 U.S.C. § 103 as being unpatentable over Parry in view of U.S. Patent No. 3,859,992 of Amstutz (hereinafter “Amstutz”) in further view of U.S. Patent No. 4,050,311 of Leach (hereinafter “Leach”), and claims 23-24 were rejected based upon Parry, Amstutz, Leach, and Official Notice. These claims were rejected based primarily upon Parry for the limitations discussed above regarding the alleged anticipation of claim 20 with further reference to Amstutz, Leach and Official Notice for various limitations. Claim 1, from which claims 2-11 depend, recites a “first end portion configured to sealingly engage with a bulb syringe,” and a head portion “configured to sealingly engage the inner surface of an acetabular liner and not substantially extend over a rim of the acetabular liner.” For purpose of this discussion, claim 1 thus includes limitations that are distinguishable over the disclosure of Parry for at least the same reasons set forth above with respect to claim 20.

Accordingly, even if Parry is modified in the manner proposed by the Examiner, such modification fails to correct the deficiencies of Parry with respect to the limitations of claims 1, 20, and 25. Therefore, the proposed modification fails to arrive at the invention of claims 1-11, 20-22, and 25-30.

Moreover, the Examiner has alleged that the modification of Parry would be made for the “obvious reason of an easy and less complicated manners of vacuum production.” (Office Action at page 11). The Examiner has failed to explain how making a device more complicated makes the device less complicated, particularly in view of the criticism of the Amstutz device in Provisional Application No. 60/541,344 at page 5, lines 15-17 which states “[t]he [Amstutz] devices are characterized by several disadvantages, including complicated designs involving several moving parts and/or external vacuum sources.”

MPEP 2142 notes that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Because the Examiner has failed to provide a clear articulation explaining why making the device of Parry more complicated would be obvious, a *prima facie* case of obviousness has not been established with respect to claims 1-11, and 20-30.

Therefore, for at least any or all of the foregoing reasons, claims 1-11 and 20-30 are patentable over the prior art.

V. Conclusion

A prompt and favorable action on the merits is respectfully requested.

Respectfully submitted,

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